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No. 785

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In the

Supreme Court of the United States

OCTOBER TERM, 1966

GEORGE H. BUTTERFIELD, SR.,

Petitioner,

vs.

THE PLASTIC CONTACT LENS COMPANY,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION

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The appendix to the Petition for Writ of Certiorari has its pages numbered 1a, 2a, 3a, etc.; and that appendix is cited thus in this brief.

To avoid confusion in page numbering, the appendix to this brief has its pages numbered 1b, 2b, 3b, etc., and it is cited herein accordingly.

IN THE

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BRIEF FOR RESPONDENT IN OPPOSITION

The petition for writ of certiorari presents no question warranting this Court's attention, and the complaints it urges are without substance. No question of interest to the public is involved; the case is but a routine one in which a plainly erroneous judgment was set right on appeal.

Opinion Below

The opinion herein of the United States Court of Appeals for the Ninth Circuit is reported at 366 F.2d 338, and is also set forth in the Appendix to the Petition, pages 17a-33a.

Jurisdiction

This Court has jurisdiction to consider the petition, by virtue of United States Code, Title 28, §1254(1).

Question Presented

In the petition it is said (page 3) that the case presents a question whether the rationale of *Automatic Radio Mfg. Co.* v. *Hazeltine Research, Inc.* (1950), 339 U.S. 827, should be *extended.* That is not so. No extension is involved; the rule of *Automatic Radio,* as originally announced by this Court, is clearly applicable to this case.

Statement Of The Case

Each of the parties to this action owns a patent, and it is important for an understanding of the case to know how the patents relate to one another.

Respondent, a contact-lens manufacturer, owns U.S. patent No. 2,510,438, known in this record as the "Tuohy patent". That patent was originally owned by a company called Solex Laboratories, Inc., and in the patent's early history it was successfully tested in several infringement actions, including one directed against respondent's lenses. The Tuohy patent was upheld by the Ninth Circuit in *Pacific Contact Labs., Inc.* v. *Solex Labs., Inc.* (9 Cir., 1953), 209 F.2d 529, and by the Southern District of California in *Solex Labs., Inc.* v. *Graham et al.* (S.D. Cal., 1958), 165 F. Supp. 428, being hailed in both those decisions as a pioneer in its field.*

---

* Tuohy's contribution lay in teaching that a contact lens should have a radius of curvature on its concave side slightly greater than the radius of curvature of the underlying cornea, thus providing in its peripheral regions "a small but gradually increasing clearance" between the lens and the eye tissue "for the entry of natural eye fluids between the lens and the cornea" (1b-4b, *infra*).

After losing the Solex infringement suit, respondent bought Solex Laboratories, Inc. and with it the Tuohy patent. At the time of this acquisition, there were already outstanding some fifty-odd patent licenses under the Tuohy patent, wherein the licensees had agreed to pay royalty at the rate of $3.50 per pair on lenses covered by the Tuohy patent and royalty at a lower scale on unfinished lenses coming under the patent or which contributorily infringed it (37a, 41a-42a, 46a).

The character of the contact-lens business made royalty accounting under such licenses inconvenient, since determining whether any particular pair of lenses embodied the Tuohy invention required reference not only to the fitter's prescription but, in the last analysis, to the fitter's measurements of the eyes to which the lenses were fitted. (This point is not in dispute; petitioner's own witness Conlogue, a lens manufacturer himself, admitted that there is no way of determining from the lenses themselves, without the underlying eye-measurement data, whether any given lens is within the scope of a particular patent. See 24b, *infra*.)

After acquiring the Tuohy patent, respondent offered, to both existing and prospective licensees, a new form of agreement granting the right to use the Tuohy invention in consideration, "solely for the purpose of accounting hereunder", of a flat royalty of $1.00 per pair on all contact lenses sold by the licensee, whether covered by the Tuohy patent or not. (This, of course, eliminated the problem, noted in the preceding paragraph, of determining which particular ones of a manufacturer's lenses were within the coverage of the patent.) All the old licensees voluntarily surrendered their existing licenses and accepted the new substitute form, and many additional manufac-

turers signed up under the new arrangement. By the time of trial, about 135 manufacturers held licenses under the Tuohy patent. (366 F. 2d, at 342, 25a; 46a; 62a; 9b, *infra*)

This brings us to the history of the Butterfield patent, No. 2,544,246, owned and exploited by petitioner. That patent is junior to Tuohy; during its prosecution, petitioner's initial broad claims of invention were rejected on the Tuohy patent as prior art, and ultimately the Butterfield patent issued with claims restricted to lenses having curvature conforming to the underlying corneal surface over their entire areas, peripheral as well as central. (5b-7b, *infra;* and see 366 F.2d, at 341; 21a)

The history of the Butterfield patent was also marked by litigation, Solex having sued petitioner's company George H. Butterfield & Son for infringement of the Tuohy patent and petitioner having counterclaimed for infringement of the Butterfield patent. After respondent bought Solex and the Tuohy patent, that litigation was settled by a consent judgment in which the validity of both patents was recognized and each patent owner was left free to solicit licenses from the licensees of the other. This consent judgment was entered in April, 1962. (366 F.2d, at 339-340; 18a-19a)

Thereafter, petitioner commenced a campaign to secure licensees for the Butterfield patent, in the course of which petitioner, and his agents and attorneys with his approval, represented to manufacturers that the Butterfield patent embraced contact lenses having two radii of differing curvature on their concave sides, regardless of whether the peripheral lens curvature conformed to the underlying corneal curvature. (13b-15b, 19b-20b, 22b, *infra*)

This campaign was quite successful; about fifty manufacturers were approached and twenty-odd licenses under the Butterfield patent were in force at the time of trial (366 F.2d, at 346, footnote 9; 33a). Recognizing that lens-by-lens accounting of royalties was an expensive and burdensome procedure, petitioner entered into numerous licenses in which the royalty was fixed at a flat sum per month, based on the licensee's total sales of contact lenses during the previous year or two years, regardless of their coverage by the patent and irrespective of whether they were finished or unfinished (10b, 17b-18b, 20b-21b, *infra*).

Petitioner's over-broad assertions to the trade as to what lenses the Butterfield patent covered were a source of alarm to some of respondent's Tuohy-patent licensees, and ultimately respondent eased this by offering its licensees an indemnity agreement. By that undertaking respondent agreed to defend any suit brought against one of its indemnified licensees for infringement of the Butterfield patent. (366 F.2d, at 344-345; 29a-30a)

Petitioner did not test the scope of his patent by an infringement suit against an indemnified Tuohy-patent licensee; instead, he initiated this action against respondent.

The complaint herein was in three counts, the first alleging unfair competition with petitioner, the second charging that the indemnity offer constituted actionable interference with contractual relationships between petitioner and his licensees, and the third alleging that respondent's patent licenses were in violation of the antitrust laws by virtue of their royalty clauses. (366 F.2d, at 340; 19a)

The District Court, in deciding for petitioner, held that the Tuohy patent was not a pioneer and that it was re-

stricted in scope to the precise type of lens illustrated in its drawing, having only one radius of curvature on its concave side. (In other words, the District Court did not even give the Tuohy patent claims their literal scope.) At the same time, the District Court held that the Butterfield patent was *not* restricted in scope to its claim language calling for conformity between lens curvature and eye curvature over the entire lens area. (38a-40a, 83a)

Having thus demoted the senior Tuohy patent to a status of minor commercial significance and elevated the junior Butterfield patent to a coverage not warranted either by its claim language or its Patent Office history, the District Court held respondent's indemnity offer and other defensive measures to be unfair competition and illegal trade restraint (366 F.2d, at 344-345; 27a-29a). The District Court also held that respondent's patent licenses wherein the royalties were proportional to the total size of the licensee's lens business were in violation of the antitrust laws and constituted illegal restraint of petitioner's business of soliciting licensees for the Butterfield patent (366 F.2d, at 342-343; 25a-26a).

By the District Court judgment, respondent was enjoined from collecting royalties or otherwise enforcing its outstanding licenses under the Tuohy patent, and was held liable to petitioner for treble damages and attorneys' fees, amount to be assessed later (14a-16a).

The Court of Appeals restored the two patents to their proper relative positions, recognizing the Tuohy patent to be the pioneer teaching of the peripheral-clearance feature and holding the Butterfield patent limited, in accordance with its claims, to lenses having two or more concentric curves conforming to eye curvature throughout the lens

area (366 F.2d, at 340-342; 20a-22a). With the District Court's basic error thus corrected, the Court of Appeals held that respondent's indemnity offer and other complained-of activities were legitimate defensive measures (366 F.2d, at 343-344; 29a-31a). The royalty clauses in respondent's license contracts, the Court of Appeals held, were legal and proper under the rule applied by this Court in *Automatic Radio Mfg. Co.* v. *Hazeltine Research, Inc.* (1950), 339 U.S. 827 (366 F.2d, at 342-343; 25a-26a). The Court of Appeals held that measuring royalties by the size of the licensee's lens business was warranted in the contact-lens industry to simplify accounting, noting that petitioner himself, for the very same reason, had granted numerous licenses in which the royalty yardstick was the size of the licensee's total business in contact lenses during the preceding year or two, regardless of patent coverage (366 F.2d, at 343; 26a; and see 10b, 17b, 20b-21b, *infra*).

Having concluded that the District Court judgment was founded on legal errors and erroneous conclusions, the Court of Appeals reversed it and directed dismissal of the action (366 F.2d, at 346; 33a).

Argument

I. Automatic Radio v. Hazeltine Is Squarely In Point; The Court Of Appeals Correctly Applied It In This Case.

Petitioner challenges the Court of Appeals judgment on the theory that *Automatic Radio* does not authorize "respondent's conduct of *exacting* royalties under its Tuohy patent on unpatented materials". As we shall now demonstrate, petitioner's point is deceptively phrased and lacking in merit:

A. Respondent Has Not "Exacted" Anything; Its License Agreements Were Voluntarily Entered Into By Respondent And Its Licensees As A Mutually Preferable, Optional Alternative To The Earlier Form Of License Having A Conventional Royalty Clause.

At the time respondent bought the Tuohy patent, there were already in force some fifty-odd licenses under it, all of which had a conventional royalty clause calling for payment of unit royalties ($3.50 per pair for finished lenses and a scale of lower rates for unfinished lenses), applicable only to lenses actually covered by the Tuohy patent (46a; and see 8b, *infra*). After respondent acquired the patent, it offered to the industry its new standard-form agreement having the royalty clause now challenged by petitioner (9b, *infra;* and see 366 F. 2d, at 342), calling for payment of royalties at a rate scaling downward from $1.00 per pair but applicable to all contact lenses sold by the licensee, regardless of patent coverage (46a; 9b, *infra*). Within a short time all of the old licensees who held licenses containing the conventional royalty clause had voluntarily exchanged them for li-

censes containing the new standard form (46a). In the same period, many other lens manufacturers took Tuohy licenses on the across-the-board royalty terms newly made available; by the date of trial, the total number of active Tuohy-patent licensees was about 135 (46a, 62a).

As the foregoing facts demonstrate, respondent has not "exacted" anything. There is no evidence or contention that any licensee, present or past, has ever been coerced into taking the present form of license as opposed to one with a conventional royalty clause. There is no evidence or contention that any licensee or would-be licensee has ever been *refused* a license having a conventional royalty clause. There is not even any contention that such a license has been *requested* by anyone since respondent's present standard form was made available.

By definition, one cannot be *refused* what he hasn't even *asked for*.

Baseless invective — nothing else — is petitioner's repeated statement that respondent "exacts" royalties on lenses not covered by the Tuohy patent. The truth is simply that all of respondent's licensees have found it preferable to contract for a convenient, easily calculable royalty measured by their total lens sales rather than to commit themselves to pay a larger unit royalty applicable only to their sales of patented lenses.

B. Petitioner Notwithstanding, Respondent's License Contracts Do Not Levy "Tribute" On Unpatented Materials; The Total Lens Sales Of Respondent's Licensees Are Simply Used As A Convenient And Reasonable Yardstick For Measuring The Value To Each Licensee Of The Rights Granted.

Plainly incorrect is petitioner's pretense that the respondent's royalty arrangements with its licensees amount to levying of tribute on unpatented materials. Respon-

dent's license agreements do no such thing, and, as we shall show in a later section, they impose no restraints or restrictions on anyone's commerce in unpatented materials. The total lens sales of the respective licensees are used, in respondent's licenses, simply as a royalty yardstick, providing a fair basis for measuring the value of the granted rights as between one licensee and another.

Obviously, a large manufacturer can reasonably be expected to benefit more from a license under a basic patent (as the Tuohy patent surely is) than a small manufacturer would. When, therefore, it is inconvenient to account for royalties on the conventional basis of so much per patented article, the arrangement provided in respondent's licenses is reasonable and in harmony with the rationale of *Automatic Radio,* providing as it does for royalty payments in proportion to the total lens businesses of the respective licensees.

This is no mere argumentative assertion; it is *proved* by the fact that *all* the fifty-odd licensees who originally had licenses with conventional royalty clauses switched over, of their own free will, to the new royalty basis (46a). It is *confirmed,* moreover, by the fact that petitioner himself, again and again, has issued licenses calling for royalties calculated on the total lens sales of the licensee, and for the very same reason—*accounting convenience* (10b, 17b-18b, 20b-21b, *infra).*

This last point, petitioner would now deny (Petition, page 11); but his own words and acts belie his denial. Witness this, as conclusive proof of that:

(a) Petitioner himself testified thus (20b, *infra*):

> "Q. Very good. Now, taking into account your explanation as to how you arrived at the monthly payments, it is a fact today, is it not, that the bulk of your licensees and substantially all of them that have

signed up within the period since the settlement of the lawsuit are paying royalties to you that are based on their total production of contact lenses as opposed to their production and sale of lenses that come under your patent?

"A. Less 25 per cent.

"Mr. Bullivant: Objected to. The license agreements are the best evidence, your Honor.

"The Court: Well, the witness may answer. What is your answer to the question?

"The Witness: I said Yes, but the rate is at a 25 per cent reduced rate over a unit license.

* * * *

"Q. The fact is that during your initial conversations with the people who signed these paid-up licenses, you explained to them that the reduction in rate from a dollar per pair to 75 cents or, if you like, from 50 cents per lens to 37½ was because the simplified arrangement saved you the expense of accounting?

"A. No.

"Q. Is it your testimony now that you told these people that the reduction in rate was because of your recognition that some of their lenses might not come under the patent?

"A. Well, I think it was rather a combination of simplifying their bookkeeping, simplifying my bookkeeping, simplifying the fact that I wouldn't have to send traveling auditors around, which costs money to audit their books."

Finished lenses and unfinished lenses (uncuts) were treated exactly alike in that calculation, as shown in this further testimony by petitioner (21b, *infra*):

"Q. Well, the point I make is that you have always charged the same royalty for uncuts as you did for finished, finished lenses; isn't that so?

"A. We have three different types of licenses.

"Q. And in all three of them there is no distinction made as far as royalty is concerned between uncuts and finished lenses; isn't that true?

"A. That's true."

(b) This is the way petitioner's lawyer, in a letter to the attorney for a prospective licensee, described petitioner's procedure for figuring the royalty to be paid (DX Q, 17b, *infra*):

"Of course, I do not know who the licensee is for whom you are inquiring, or how many lenses it has sold in the past, but I can tell you generally the basis upon which Dr. Butterfield arrives at the sum to be paid for a paid-up license and a release for past infringement:

"He estimates the number of lenses to be sold hereafter until the end of the term of the patent (about six years) by taking the average number of lenses which the licensee has sold in the past two years, and considers that it will probably sell an equal number of lenses per year during the remaining life of the patent. Then, instead of his regular per lens royalty of 50 cents, which he charges for a license on a per-lens basis, he makes the royalty 37½ cents per lens for the paid-up form of license because thereby he saves accounting expenses.

"In other words, to state an example, if during the past two years your client has sold an average of 4,000 lenses per year, he would figure that during the next six years they would sell 24,000 lenses, which, at 37½ cents per lens, would be $9,000.00, which would be the paid-up sum."

There is even more evidence proving that petitioner, for accounting convenience, calculated royalties in his own licenses on total lens sales rather than sales of patented articles (e.g., 10b, *infra*). But the above-quoted examples

will suffice to show that the Court of Appeals (366 F. 2d, at 343; 26a), and not petitioner (Petition, page 11), should be believed on that issue.

To sum up: Without substance is petitioner's claim that respondent levies "tribute" on "unpatented materials". The total lens sales of respondent's licensees are a mere yardstick for measuring the value to them of the rights granted. Under the circumstances disclosed by this record, that is both reasonable and legal.

C. The Automatic Radio Rule Applies A Fortiori To The Facts Of This Case.

In *Automatic Radio Mfg. Co.* v. *Hazeltine Research, Inc.* (1950), 339 U.S. 827, the license conferred rights under a large group of patents relating to radio equipment. The consideration for the rights granted was a royalty measured by a percentage of the licensee's total sales of radio receivers, regardless of whether, in specific instances, the receivers utilized the inventions of any of the licensed patents.

The legality of the agreement was challenged on the ground that it was a misuse of patents and illegal restraint of trade "to require the licensee to pay royalties based on its sales, even though none of the patents are used" (339 U.S., at 830). This Court rejected that contention and held the terms of the agreement legal, saying (339 U.S., at 833):

> "The Court of Appeals reasoned that since it would not be unlawful to agree to pay a fixed sum for the privilege to use patents, it was not unlawful to provide a variable consideration measured by a percentage of the licensee's sales for the same privilege. 176 F. 2d at 804. Numerous District Courts which have had occasion to pass on the question have reached the same result on similar grounds, and *we are of like opinion.*"

Continuing (339 U.S., at 834), this Court noted that circumstances might make a royalty measured by the size of a licensee's sales "the most convenient method of fixing the business value of the privileges granted by the licensing agreement", and pointed out that such a royalty provision involves "no inherent extension of the monopoly of the patent."

In so ruling, this Court was plainly right, and its reasoning applies *a fortiori* to the facts of this case. Here the respondent's licensees took on the across-the-board royalty arrangement as a *voluntarily substituted alternative* for a conventional royalty of so much per pair of patented lenses; and there is no suggestion in the record that any of them has even *asked*, at any time, to return to the old arrangement. It is preposterous for petitioner to suggest, under circumstances such as those, that respondent's royalty clauses are impositions or restraints on anyone.

Totally without merit are petitioner's lame efforts to distinguish *Automatic Radio* from the case at hand:

> *First* (Petition, pag. 15), petitioner makes the point that in *Automatic Radio* the license agreement conferred rights under hundreds of patents instead of only one, as here. That is no distinction. This Court's ruling in *Automatic Radio* was that an across-the-board royalty base may be used when for business reasons it is inconvenient to employ the conventional basis of so much royalty per patented device sold. Here, the record establishes that the conventional procedure is inconvenient for all concerned, as confirmed by petitioner himself.

Second (Petition, page 15), petitioner advances the pretension that in *Automatic Radio* there was no showing that the sales on which royalties were figured included items falling under patents held by others than Hazeltine. This is absurd. It is, of course, common knowledge that radio receivers in the 1940's were literally blanketed by patents, of many different companies. (For example, see *United States* v. *Radio Corporation of America, et al.* (D.C. Del., 1954), 117 F. Supp. 449.)

Third (Petition, pages 15-16), petitioner, invoking the discredited and clearly erroneous legal conclusions of the District Court, asserts that respondent's contracts should be struck down because of other acts of respondent, alleged by petitioner to be wrongful. One answer to that is that the Court of Appeals has corrected the District Court's errors and held what anyone reading this record with a clear eye can see—that petitioner has been the real aggressor all along and respondent's complained-of acts have been nothing more than defense measures. A second answer, equally to the point, is that the genesis of respondent's royalty contracts had *no connection whatever* with petitioner. The great bulk of the license agreements now complained of were in force before the consent judgment that marked the beginning of petitioner's licensing program (46a).

Finally (Petition, page 16), petitioner seeks to distinguish *Automatic Radio* by asserting that a suit between the parties to a license contract, as that one was, is not the same as a case like this where petitioner is collaterally attacking respondent's contracts. That, if ever there were one, is a distinction without a difference. If there were substance in petitioner's claim that respondent's royalty clauses are inhibiting its licensees from signing up with petitioner, surely petitioner could have found *one* such licensee willing to *ask* respondent to substitute a conventional royalty clause for the one now in force.

Beyond any doubt, the Court of Appeals was right in holding this case governed by *Automatic Radio.*

II. Petitioner's Invocation Of The Tie-In Cases Is Off The Mark; They Have Nothing To Do With This Case.

Following the lead of the unsuccessful petitioner in *Automatic Radio,* the present petitioner (Petition, pages 19-20) relies on the tie-in cases such as *B.B. Chemical Co.* v. *Ellis* (1942), 314 U.S. 495 and *Mercoid Corp.* v. *Mid-Continent Investment Co.* (1944), 320 U.S. 661, which rightly established the principle that a patentee may not by contract enlarge his monopoly by conditioning the grant of patent rights on the licensee's purchase, rental, or use of unpatented material derived from the patentee.

The law those cases stand for is good law indeed, but it has no relevance to this case:

(a) In *B.B. Chemical* (1942), 314 U.S. 495, the grant of the right to use a patented method was conditioned on the purchase of unpatented materials from the patentee.

(b) In *Mercoid* (1944), 320 U.S. 661, the right to use the combination protected by the Cross patent in suit was granted only to users who purchased stoker switches—unpatented elements of the combination—from the manufacturer the patentee licensed to supply them.

(c) In *Carbice* (1931), 283 U.S. 27, licenses were granted only to users who purchased unpatented dry ice from the patentee.

(d) In *Leitch Mfg. Co.* v. *Barber Co.* (1938), 302 U.S. 458, it was held that the owner of a patent on a method of curing concrete by the use of bituminous emulsion (*per se* unpatented) could not enjoin as a contributory infringer a competing manufacturer who knowingly sold the emulsion for use in practicing the patented method.

Obviously, every one of those tie-in cases involved a situation where license rights in a patented invention were used to procure for the patentee a monopoly position in an unpatented product. Nothing remotely like that exists here. Respondent's licensees are not obliged to buy anything from anybody, and they are free to sell anything they choose to anyone they choose, at any price they choose. The same thing, of course, was true in *Automatic Radio*, wherein the tie-in cases were also cited but rightly held irrelevant (339 U.S., at 832-833).

III. This Record Presents No Issue Under Rule 52(a).

Petitioner's third asserted reason for granting the writ (Petition, page 13) was the contention that the Court of Appeals, in reversing the judgment of the District Court, failed to honor Rule 52(a).

By failing to argue the point, petitioner has tacitly conceded that it lacks merit; and he is surely right. The District Court judgment in this case was grounded on gross errors of law, and the so-called "findings of fact" are literally full of legal conclusions. The evidentiary facts were not in serious dispute and were not disturbed by the Court of Appeals. In reversing the judgment, the Court of Appeals just corrected the District Court's errors of law and threw out its unsound legal conclusions.

Conclusion

The petition for the writ of certiorari should be denied.

Respectfully submitted,

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PAGE

PLAINTIFF'S EXHIBIT No. 43

June 6, 1950 K. M. TUOHY 2,510,438

CONTACT LENS

Filed Feb. 28, 1948

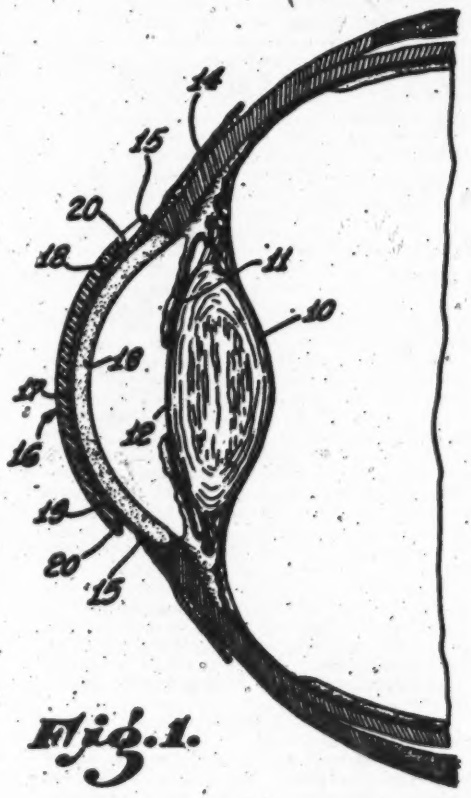

Fig. 1.

Fig. 2.

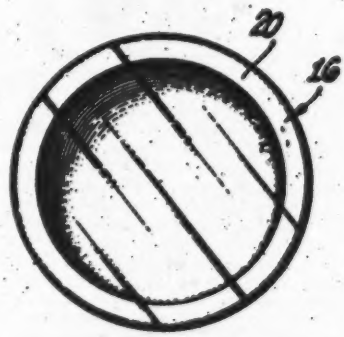

Fig. 3.

Fig. 4.

Fig. 5.

INVENTOR.
BY Kevin M. Tuohy
Hazard & Miller
ATTORNEYS.

Patented June 6, 1950 2,510,438

UNITED STATES PATENT OFFICE

2,510,438

CONTACT LENS

Kevin M. Tuohy, Los Angeles, Calif., assignor to Selsr Laboratories, Inc., Los Angeles, Calif., a corporation of California

Application February 23, 1948, Serial No. 12,040

2 Claims. (Cl. 88—54)

1

This invention relates to a contact lens adapted to be applied to the human eye for the primary purpose of correcting deficient vision.

Heretofore contact lenses have been produced that have been made of either glass or synthetic resin plastics which have portions resting directly on the cornea of the eye with a supporting flange or border resting on the scleral portion of the eye or which have central portions arching over the cornea and which have flange or border portions designed to extend beyond the limbus of the eye. The optical correction has been ground on that portion of the contact lens disposed over the cornea and fluids compatible with the eye tissue have generally been interposed between the lens and the eye. Such contact lenses have had a number of objections which have, either collectively or individually, retarded their general use. Among these objections are (1) the time and skill required to properly fit the lenses to the eyes of the patient; (2) the lack of comfort which prevents such contact lenses from being worn continuously longer than only relatively short times; (3) the development of the appearance of rainbows or halos, particularly around bright light sources and the clouding of the vision after the lenses have been worn for a relatively short time; and (4) the necessity of determining and then using fluids with the contact lenses which are compatible with the eye tissues of the user.

I have ascertained that one important source of these objections is occasioned by the fact that the contact lenses heretofore devised universally engage the scleral portion of the eye so that the pressure of the flange or border portion of the contact lens on the scleral portion not only applies objectionable pressure to the nerves in the eye but retards the normal blood flow through the veins in the scleral position. The pressure on the nerves and the retarding of the normal blood flow is conducive to the development of irritation and is a principal reason for the appearance of the objectionable rainbows, halos and cloudiness. The contact lenses heretofore developed, even when removed for the purpose of resting the eye, do not bring about immediate relief on removal and, due to the fact that they cover such a wide expanse of the eye, they must be fitted with a relatively high degree of accuracy by one who is highly skilled in this type of work. With the use of contact lenses which extend beyond the limbus portion the eye is almost completely covered and with the fluid sealing off all possibility of air and natural eye fluids the eye soon becomes exhausted.

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An object of the present invention is to provide an improved contact lens which is characterized by the fact that when properly fitted to the eye of the person for which it was designed its maximum dimensions will be less than the dimensions across the limbus at the edges of the cornea. In the preferred arrangement, the contact lens embodying the present invention is smaller in size than the iris but larger than the maximum pupil opening. This is particularly true when the lens and the iris are considered along the horizontal meridian. When considered on the vertical meridian the lens may exceed the iris slightly but still should be within the limbus. In this manner as the lens normally does not engage the sclera, the sclera is exposed to air and natural eye fluids and is not subjected to the objections arising from pressures applied thereto.

A further important characteristic of the improved lens resides in the fact that although it is in the nature of a concavo-convex section of transparent material largely conforming in shape and size to the cornea of a given eye, the inside or concave surface actually is slightly flatter or may be regarded as having a slightly greater radius of curvature than the cornea. In this manner the lens may actually contact the cornea near the center of the lens while the portions of the lens adjacent its margin are slightly spaced therefrom. This space affords an opportunity for the natural eye fluids to enter and relieves pressure on the cornea. Although blinking of the eyelids may displace the lens from over the cornea temporarily so that its edges may extend across the limbus and even onto the sclera, the minimum contact between the lens and the cornea occasioned by this relation of curvatures is such as to reduce the irritation, if any is present, to a minimum.

With the foregoing and other objects in view, which will be made manifest in the following detailed description and specifically pointed out in the appended claims, reference is had to the accompanying drawings for an illustrative embodiment of the invention, wherein:

Figure 1 is a vertical section on an enlarged scale through the forward portion of a human eye illustrating a contact lens embodying the present invention in applied position thereon;

Figure 2 is a front view in elevation of the contact lens illustrated in Figure 1;

Figure 3 is a rear view in elevation of the same;

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Figure 4 is a front view in elevation of a slightly modified form of construction; and

Figure 5 is a vertical section taken substantially upon the line 5—5 upon Figure 4.

Referring to the accompanying drawings wherein similar reference characters designate similar parts throughout, in Fig. 1 the lens of the eye is indicated at 10 over which there is the iris 11 which defines the pupil 12. The cornea is generally indicated at 13 and the sclera generally indicated at 14. The limbus portion which defines the sclera from the cornea is indicated at 15.

The contact lens embodying the present invention consists of a concavo-convex section 16 of any suitable transparent or semi-transparent material. This material may be optical glass or, in conformity with conventional practice, it may be a synthetic resin plastic of the type now generally being employed in the manufacture of contact lenses. The material in the usual situation may be perfectly transparent but in some instances it may be slightly darkened or tinted either for glare-reducing purposes or to enhance or modify the natural color of the iris 11 in securing desired cosmetic effects.

This section will, of course, vary in size and shape to conform to the particular eye to which it is fitted but in embodying the present invention it possesses the following characteristics. The maximum dimension such as the diameter of the lens is less than the corresponding dimension of the iris so that the margins of the lens when in the normal applied position are within the iris 11. However, the lens is not so small that it will not completely cover the pupil 12 when the iris 11 is in its fully opened position. The lens may, therefore, be defined as to size as being within the limbus of the eye but beyond the maximum opening of the iris. Another characteristic of the lens is that it has a radius of curvature slightly greater than the radius of curvature of the cornea to which it is applied or, in other words, the lens is slightly flatter on its concave side than the convexity of the cornea. In this manner the major portion of the contact between the lens and the cornea will occur near the center of the cornea or in the neighborhood of the location indicated at 17, whereas at the top and bottom of the lens, as well as at the two sides there will be slight clearance spaces 18 and 19. I find its advisable to have a slight difference between the radius of curvature of the concave side of the lens and the convex surface of the cornea so as to reduce irritation. The clearance spaces 18 and 19, as well as the clearance spaces at the sides of the lens, enable the natural eye fluids to enter between the lens and the cornea which is, of course, desirable. The presence of this fluid in these clearance spaces probably contributes to the holding of the lens in place on the cornea such as by capillary action. The optical correction may be ground either on the interior or exterior surface of the lens 16 or both, and in some instances the optical correction ground on the interior surface of the lens is adequate to provide the clearance spaces 18 and 19. In other words, the lens blank may initially have an interial radius of curvature exactly conforming to the radius of curvature of the cornea but on grinding the optical correction on the interior of the lens its concave radius of curvature may be so altered thereby as to provide the clearance spaces which are of adequate size. These clearance spaces need not be great and, for example, if the radius of curvature of the cornea measures

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7.8 millimeters the radius of curvature of the concave side of the lens need only be 7.9 or possibly 8.0 millimeters.

I find it advantageous in the usual lens to bevel the concave surface adjacent the margins, as indicated at 20. When the lens is in applied position on the eye the eyelid, in blinking or closing thereover, will tend to disturb the position of the lens on the cornea. Usually most of this disturbance is created by the upper eyelid which, on opening, may tend to lift the lens from the full line position shown in Fig. 1 to a dotted line position therein and, as illustrated in the dotted line position the lens may be temporarily shifted upwardly so that it has crossed over the limbus portion 15 and may even extend partially onto the sclera 14. This displacement of the lens is usually only temporary and subsequent blinking or closing of the eyelid will tend to restore the lens to its centralized position with relation to the cornea. As the limbus portion 15 usually protrudes slightly the internal bevel 20 facilitates the slipping of the lens thereover so that when displacement of the lens does take place it may occur without causing irritation. When the lens is returned to the cornea in the course of subsequent blinking, it tends to centralize itself thereon.

Any necessary correction may be ground on the surfaces of the lens and in some instances the correction required is such that the lens must be either relatively thick or have relatively thick margins. Where the lens is thick or has thick margins the external or convex surface may be beveled as indicated at 21 to facilitate the passing of the conjunctiva of the eyelids thereover. Both bevels 20 and 21 should be relatively small and should be confined to the distance between the maximum opening of the iris and the limbus portion 15 so that the user under no circumstances will look through a beveled portion of the lens.

In Fig. 4 a slightly modified form of construction is illustrated wherein the lens, instead of being circular in form, is slightly ovate or elliptical. The lens may be given any shape required to properly fit the size and shape of the cornea to which it is applied.

It will be noted from the above described construction that the improved contact lens is relatively simple. A feature of its construction resides in the fact that in its normal position shown in Fig. 1 no portion of the lens contacts the sclera and consequently the irritation generally produced when contact lenses are pressing against the sclera is entirely avoided. Furthermore, the prescribing of lenses of this character is greatly simplified. Whereas heretofore it has generally been necessary to form a mold of the eye to determine the size and shape of the cornea and the size and shape of the surrounding sclera, in the present construction the size and shape of the sclera becomes relatively immaterial. The prescription for the required correction can be determined in the usual manner and the corneal portion of the eye can then be measured both horizontally and vertically by any conventional measuring instrument used for this purpose. With the measurements of the cornea known both as to height, width and radius of curvature and the required correction known, a lens manufacturer can easily fill a prescription for contact lenses with reasonable assurance that the lens will fit the patient properly. In so doing his skill and judgment may be required in determining whether or not a lens blank having a larger in-

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ternal radius of curvature than that of the cornea shall be used or whether the lens may have the same internal radius of curvature and the correction ground on the inside of the lens be relied upon to form these clearances. In the use of the improved lens it is unnecessary to try repeatedly and reject various solutions or fluids before wearing time can be gained inasmuch as no solution need be used at all with the present lens. However, in applying the lens embodying the present invention it is frequently advisable to moisten its surfaces so that at the time of initial application there will not be any discomforture particularly of the eyelids. No special fluid or solution is required for this purpose and ordinary water not harmful to the eye may be employed to moisten the lens. When the lens is worn its presence can rarely be detected. Even the bevels at the margins of the lens can rarely be detected due to the fact that they are within the iris portion, the edges of the lens particularly at the sides of the iris being backgrounded by the colored iris and to a large extent undiscernible and although the lens at the top and bottom of the iris projects or slides beyond the iris these portions are normally concealed by the upper and lower eyelids.

I find that lenses of this character can be worn over prolonged periods of time—periods of twelve and thirteen hours of continuous use being not unusual—without causing objectionable irritation and without causing cloudiness or rainbow and halo effects which are frequently produced with the usual contact lens in very much shorter periods of time.

I find it advisable to mark the lenses so as to be able to distinguish the lens for the right eye from the lens for the left eye and to indicate which side of the lens should be positioned uppermost and lowermost as the case may be. Such markings may be very small and when applied should be applied very close to the margin of the lens and if the lens is beveled they should be applied to a bevel.

Various changes may be made in the details of construction without departing from the spirit and scope of the invention as defined by the appended claims.

I claim:

1. A contact lens applicable to the human eye comprising a concavo-convex lens formed of light-transmitting material having a marginal size smaller than the limbus portion of the eye to which it is applicable but larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea, said lens being ground to correct for visual deficiency.

2. A contact lens applicable to the human eye comprising a concavo-convex lens formed of light-transmitting material having a marginal size smaller than the limbus portion of the eye to which it is applicable but larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea, said lens being ground to correct for visual deficiency and having a bevel at its marginal edges on the concave side thereof.

KEVIN M. TUOHY.

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The following references are of record in the file of this patent:

UNITED STATES PATENTS

Number	Name	Date
722,009	Volk	Mar. 3, 1903
2,000,763	Links	May 7, 1937

FOREIGN PATENTS

Number	Country	Date
805,582	France	Aug. 31, 1936

OTHER REFERENCES

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Obrig (Text) "Contact Lenses," 1942, publication by the Chilton Co., Philadelphia, Pa., pages 370 to 373 inclusive and pages 129 and 130.

"Contact Lenses," (publication) by E. Freeman O. D., published in The Optometric Weekly, February 22, 1945, pages 271 and 276.

"The Design of Contact Lenses" by Vincent Hill, published in "The Optician," May 22, 1947, pages 305, 333, 337 and 341.

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PLAINTIFF'S EXHIBIT No. 45

March 6, 1951 G. H. BUTTERFIELD 2,544,246

CORNEAL CONTACT LENS

Filed Aug. 1, 1950

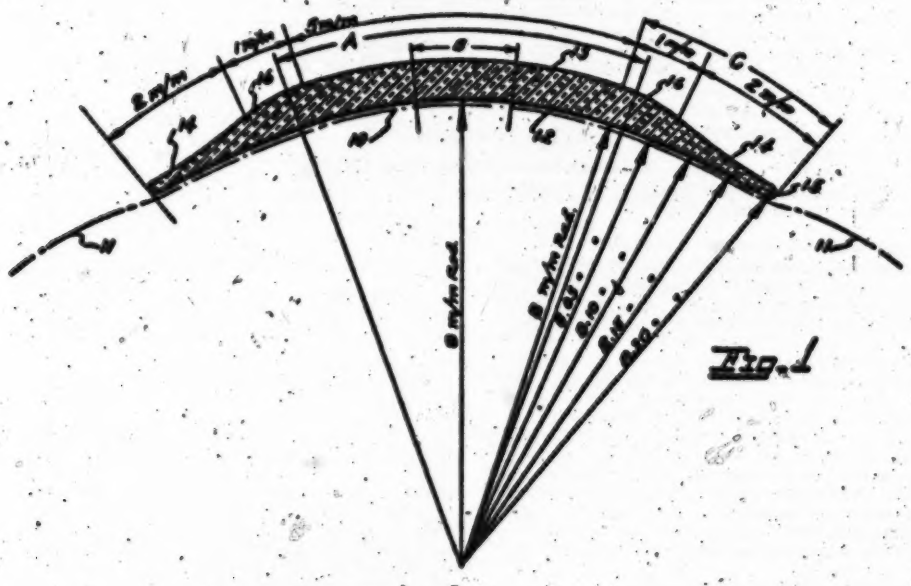

Fig. 1

Fig. 2

GEORGE H. BUTTERFIELD
INVENTOR.

BY

James A. Edwards
ATT'Y

Patented Mar. 6, 1951 2,544,246

UNITED STATES PATENT OFFICE

2,544,246

CORNEAL CONTACT LENS

George H. Butterfield, Portland, Oreg.

Application August 1, 1950, Serial No. 177,859

3 Claims. (Cl. 88—54.5)

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This invention is a continuation in part of my application S. N. 107,948 filed August 1, 1949 and relates to contact lenses and more particularly to a contact lens that covers the corneal region of the eye.

The conventional contact lens, that is, the contact lens which has a scleral flange molded to fit the eyeball has many limitations. Not the least among these is the fact that the wearing time is quite short; a few hours' wear causes a corneal misting or halation brought about presumably by the pressure of the lens cutting off blood circulation in the limbal region and the prevention of free flow of lacrimal fluid. Other factors preventing this lens from coming into wide use are the need for a special accessory fluid between the lens and the eye. In addition, the difficulties of fitting them to the individual eyeball are apparent and well-recognized. For that reason, a practical corneal lens has been much sought after. In theory, the corneal lens is the ideal method of correcting visual deficiencies, since it does not touch the limbal region, needs no accessory fluid, and has other beneficial optical properties known to workers in the art.

The applicant, in his invention, has provided a corneal lens which can be worn continuously throughout the full waking day by the average person without experiencing corneal blurring or discomfort of any kind.

Furthermore, the lens of the applicant overcomes a common deficiency of corneal lenses, that is, their tendency to fall away from the eyeball due to insufficient surface tension or capillary attraction or due to the eyelid lifting the lens away from the cornea.

In addition, the applicant has provided a contact lens which needs no accessory fluid, which does not give the eye a bulging appearance, which is perfect from the viewpoint of cosmetology and ophthalmology, which is self-cleaning, which is easy to fit, which is free of marginal aberrations, which can be used by persons with pathological conditions of the cornea, and which may be easily and inexpensively manufactured.

With the above objects in view, as well as others which will appear as the specification proceeds, the invention comprises the construction, arrangement, and combination of parts as now to be more fully described and as hereinafter to be specifically claimed, it being understood that the disclosure is merely illustrative and intended in no way in a limiting sense, changes in details of construction and arrangement of parts being permissible so long as within the spirit of the

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invention and the scope of the claims which follow.

In the accompanying drawings:

Figure 1 shows a greatly enlarged sectional view of the lens of the present invention taken through the center thereof.

Figure 2 shows a greatly enlarged view of the anterior, convex face of the lens of the instant invention.

Referring to Figure 1, the lens which may be made of methyl methacrylate or similar substances is shown in conjunction with a human eyeball, shown in broken lines. The reference character 10 designates the surface of the cornea while the limbal region is designated 11. Generally speaking, the lens of the applicant is of concavo-convex type and consists of a posterior, concave side 12 and an anterior, convex side 13. The concave side 12 is of a perfectly spherical shape over the central area of the lens indicated by the dimension 5 mm. It is to be noted that, the lens shown in the drawing is provided with dimensions; these dimensions are given to show the relative proportionalities between the parts of the lens. The particular lens shown is illustrative of a lens particularly made for a person having a cornea whose radius of curvature in the central portion is 8 mm. The diameter of the central area designated by the dimension 5 mm. is slightly smaller than the maximum diameter of the pupil, the latter diameter being indicated by the dimensional character A. The convex side 13 of the lens is formed in the central portion with the curvature needed to supply the needed visual correction to the eye; the area that is thus formed is also slightly less in diameter than the maximum diameter of the pupil. The area subtended by the pupil in its minimum contracted condition is indicated by the character B. The curvature of the concave side 12 of the lens changes as the point on the surface is further from the center of the lens; at the edge of the area indicated by the 5 mm. dimension the radius of curvature becomes progressively greater until it reaches a maximum at the outer edge 15 of the lens. In the preferred embodiment shown in the drawing, the radius of curvature increases by 2½% from the central spherical area to the edge 15. The outside diameter of the lens must, of course, be such that the lens may lie on the surface of the cornea 10 within the area defined by the limbus 11. Actually, the concave side 12 of the lens approximates the surface of a paraboloid for a reason to be discussed later.

The anterior or convex side 13 of the lens is

formed with a rim portion 14 adjacent to the edge 15. This rim portion is relatively thin and its surface is generally parallel to the surface of the concave side throughout its extent. The rim portion 14 can be said to extend approximately 2 mm. inwardly of the edge 15 and it is indicated by the dimension 2 mm. Between the central vision-correcting portion of the convex side of the lens and the rim portion 15 is a transition area indicated by the dimension 1 mm. This transition area has a smoothly curved surface leading from the thick central part of the lens to the thin outer part and should be such as to present no abrupt changes in contour that may be engaged by the conjunctiva of the eyelid causing displacement of the lenses. The outer edge 15 of the lens is formed as a smoothly rounded surface.

The operation of the lens is based on the fact that the average human cornea is not exactly spherical, but actually is more like a paraboloid, with the central, visual portion being a sphere to all intents and purposes, but with the radius of curvature becoming greater as one leaves the visual area and progresses outwardly toward the limbus.

Yet, in the past, all corneal lenses have been made on the theory that the cornea was spherical throughout and the concave side of the lens has been made spherical also. It can be seen that if a spherically surfaced lens is used on a paraboloidal cornea, the lens will necessarily contact the cornea at the conus and at the edge. Now, the sphere and the paraboloid are quite similar at the conus and no undue pressure takes place; at the edge, however, the pressure is great enough to cause discomfort and blurring. If the spherical surface of the lens in such a case is chosen large enough to prevent this localized pressure, the lens will be too loose and will easily separate from the cornea because of insufficient capillary attraction and because there will necessarily be a large space between the cornea and the edge of the lens and the eyelid will slip under the lens and lift it.

Now, the theory behind all corneal contact lenses is that the lens be so formed that it can ride on a film of lacrimal fluid which exists between cornea and contact lens; if the lens does not float on such a film or causes a local pressure, there will be discomfort, halation, and the like and if the space between lens and cornea is too great, the capillary attraction will not exist and the lens may fall away from the eye. The applicant, by providing a lens whose contact surface is very close to the shape of the eyeball, has brought about the ideal corneal contact lens condition.

Since none of the lens outside of the area of the maximum extension of the pupil, designated A in the drawing, is to be used for overcoming the sight deficiency and is only present to present the maximum contact area between lens and cornea for maximum capillary attraction, it is possible for the applicant to use the non-visual area in a way to best overcome the past deficiencies of corneal contact lenses. The particular shape provided allows the eyelid to slide smoothly over the edge of the lens. The result is that there is no pain or sensation in the eyelid, and there is no opportunity for the eyelid to pry the lens away from the cornea.

I claim:

1. A corneal contact lens of concavo-convex form in section and of a size to lie within the area defined by the limbus having an inner central spherical area conforming to the corresponding area of the cornea to which the lens is applied so that undue pressure will not be present at any point, the remainder of said inner surface extending radially outward toward the limbus being formed on a curve different from that of said central area and corresponding in curvature with that portion of the corneal peripheral area to which the lens is applied, whereby space is provided for the natural uninterrupted circulation of lacrimal fluids between said lens and the cornea.

2. A corneal contact lens as in claim 1 wherein the anterior marginal area is gradually reduced in thickness toward the periphery of the lens by an arcuate facing in reverse curvature to the convex surface of the lens, both the junction of said arcuate facing with the remaining central convex portion and the lens edge having a smooth transition whereby the eyelids may pass freely over said edge.

3. A corneal contact lens as in claim 1 wherein the anterior marginal area is gradually reduced in thickness toward the periphery of the lens by a concave facing in reverse curvature to the convex surface of the lens, both the junction of said concave facing with the remaining central convex portion and the lens edge having a smooth transition whereby the eyelids may pass freely over said edge.

GEORGE H. BUTTERFIELD.

REFERENCES CITED

The following references are of record in the file of this patent:

UNITED STATES PATENTS

Number	Name	Date
2,516,439	Tuohy	June 6, 1950

FOREIGN PATENTS

Number	Country	Date
805,582	France	Aug. 31, 1936

OTHER REFERENCES

"The New Hamblin-Dallos Contact Lens" (publication), page 143 of "The Optician," April 1, 1938.

"Contact Lens Note" (publication), page 86 of "The Optician," March 4, 1947.

"Changes in the Form of the Contact Lens Optic" by Jones, published in "The Optician," December 31, 1948, pages 617 and 618.

"The Question of Contact Lens Design," publication appearing in "The Optician," Feb. 4, 1949, pages 97 to 98.

"The Corneal Lens" by Dickenson, from the publication "The Optician," September 2, 1949, pages 141 to 144.

"Corneal Contact Lenses" by Eier, published in "The Optician," September 9, 1949, page 185.

PLAINTIFF'S EXHIBIT NO. 46 (Excerpt)

(Royalty clause in the early Tuohy-patent license agreements, in force before respondent's present standard license form was introduced)

• • • •

2.

CENTRAL agrees to pay to SOLEX a royalty of Three Dollars and Fifty Cents ($3.50) per pair, or One Dollar and Seventy Five Cents ($1.75) per single lens on all finished lenses manufactured and sold by CENTRAL and covered by Tuohy Patent No. 2,510,438 or which would contributorily infringe said patent; and a royalty on all unfinished lenses manufactured and sold by CENTRAL under said Tuohy patent, or which would contributorily infringe said patent in accordance with the following schedule:

$2.00 on the first	50,000 pair	or $1.00	per lens
$1.00 on the next	50,000 pair	or $ .50	per lens
$ .75 on the next	100,000 pair	or $ .375	per lens
$ .50 on the next	100,000 pair	or $ .25	per lens
$ .25 on all additional pair		or $ .125	per lens

CENTRAL shall not pay royalties to SOLEX on lenses purchased from SOLEX or from a direct licensee of SOLEX, but such lenses shall not be counted in the total number of lenses sold by CENTRAL under the schedule hereinabove.

PLAINTIFF'S EXHIBIT NO. 46 (Excerpt)

(Royalty clause in respondent's present standard form of Tuohy-patent license)

• • • •

2.

(a) LICENSEE, solely for the purpose of accounting hereunder, agrees to pay to LICENSOR royalties upon all devices consisting of pieces of finished material in which two lens surfaces are applied thereto and which are adapted to be or are made into a finished or unfinished corneal lens calculated in accordance with the following schedule on all such devices sold by LICENSEE:

$1.00 on each pair of the first 150,000 pairs of devices or $ .50 per device.

$. 75 on each pair of the next 100,000 pairs of devices or $ .375 per device.

$ .50 on each pair of the next 100,000 pairs of devices or $ .25 per device.

$ .25 on each pair of all additional pairs of devices or $ .125 per device.

LICENSEE shall not pay royalties to LICENSOR on finished or unfinished lenses (.ie. lenses upon which two lens surfaces are already formed) when purchased from LICENSOR or from a Licensee of LICENSOR and such lenses shall not be counted in the total number of devices sold by LICENSEE under the schedule hereinabove.

PLAINTIFF'S EXHIBIT NO. 84F (Excerpt)

(Excerpt from petitioner's agreement with Dippery and Case appointing them exclusive licensees under the Butterfield patent in certain states, with the right and obligation to solicit and grant sub-licenses)

* * * *

IIIA.

LICENSEE agrees that it will only grant sublicenses which conform to Exhibit A (unitary license form) or Exhibit B (paid up license form) attached hereto and will only grant releases for past infringement in the form of Exhibit C, attached hereto. LICENSEE agrees that if the paid up license (Exhibit B) is granted any sublicensee, it will compute the amount of royalty as follows:

Add the total sales of proposed licensee, reasonably verified from business records exhibited, of manufactured contact lenses, in the year immediately preceding the intended commencement date of the license agreement. Divide this total of single lenses by 12 to arrive at an average monthly figure of sales of single lenses. This figure as to average monthly sales of single lenses shall then be multiplied by 50 cents per lens. The result so obtained is the monthly payments measured by the then unexpired portion of the life of the Canadian patent, disregarding fractions of less than one-half month. The Canadian patent expires November 11, 1969. In the case of manufacturers doing business more than six (6) months and less than twelve (12) months, the total production record shall be used and the result divided by the nearest total number of months in business, which result, multiplied by 50 cents per single lens, shall become the monthly rate.

PLAINTIFF'S EXHIBIT No. 143G

August 7, 1962

CERTIFIED MAIL

Acrylic Optics Corporation
1926 First National Building
Detroit, Michigan

Gentlemen:

From a copy of your prospectus which has come to the attention of our client, Dr. George H. Butterfield of Portland, Oregon, it appears that your newly formed corporation contemplates the manufacture and sale of corneal contact lenses which, from the description of the lens contained in the prospectus, appears to be a bi-curved or multi-curved lens which will infringe our client's United States Letters Patent No. 2,809,556, and our client feels it proper to place you upon notice that he intends diligently to enforce his patent rights and to demand that you refrain from infringing his patent.

Our client is granting and has for several years granted license rights under his patent either upon a paid-up basis or a per lens royalty basis.

It is noted from your prospectus that your corporation holds or will hold a license from the Plastic Contact Lens Company. That company also has held a license under our client's patent for several years. Also, it should be mentioned that, in settlement of patent litigation in the United States District Court for the District of Oregon between Solex Laboratories, Inc. and the Plastic Contact Lens Company, on the one hand, and Dr. George H. Butterfield, et al. on the other hand, a consent judgment was entered holding that Solex Laboratories, Inc. had infringed our client's said patent, as will all appear from the copy of the Consent Judgment and the Stipulation as

to Facts and Matters upon which it was based, enclosed herewith.

You should bear in mind that although you may hold a license under any other patent or patents, the license does not convey to you any right or make or sell the lens of our client's patent.

Will you be good enough to advise us promptly of your intentions in this matter?

Very truly yours,
of MASON & GRAHAM

CM b
Encs.
bc: Dr. George H. Butterfield
Mr. Rupert R. Bullivant

• • •

PLAINTIFF'S EXHIBIT No. 143F

(Letterhead of)
FENTON, NEDERLANDER, TRACY & DODGE

August 15, 1962

Collins Mason, Esq.
Mason & Graham
811 West Seventh Street
Los Angeles 17, California

Re: Acrylic Optics Corporation—Butterfield

Dear Mr. Mason:

We are general counsel for the Acrylic Optics Corporation. Dr. Golden forwarded your letter of August 7, 1962 to our office and we are happy that you called this matter to our attention.

Inasmuch as we are interested in obtaining all information with regard to your client's patent, I would appreciate if you would send me any and all information as to how and in what manner our client has infringed upon your client's patent. Naturally, it is not his intention to do so. If, after examination of all the facts, it is determined by our office that there is an infringement, it would immediately attempt to resolve this problem.
Thank you for your cooporation.

Sincerely,
/s/ R. Nederlander
Robert E. Nederlander

REN:sm

(Mail Receipt Stamp)
Received
Aug 16 1962
Mason & Graham

• • •

PLAINTIFF'S EXHIBIT No. 143E

August 27, 1962

Mr. Robert E. Nederlander
Fenton, Nederlander, Tracy & Dodge
2555 Guardian Building
Detroit 26, Michigan

Re: *Butterfield Patent*

Dear Mr. Nederlander

Replying to your letter of August 15, 1962. From his long experience in the corneal contact lens business, undoubtedly Dr. Golden is familiar with the Butterfield patent. However, we enclose a copy of his patent for your study.

Generally speaking, we believe you will find that the Butterfield patent covers a bi-curved or multi-curved lens made to be fitted substantially "on K".

Very truly yours,
of MASON & GRAHAM

CM B
Enc.
bc: Dr. George H. Butterfield, Sr.
Mr. Rupert R. Bullivant

• • •

PLAINTIFF'S EXHIBIT No. 143D

(Letterhead of)
FENTON, NEDERLANDER, TRACY & DODGE

August 30, 1962

Mr. Collins Mason
Mason & Graham
811 West Seventh Street
Los Angeles 17, California

Re: Butterfield Patent

Dear Mr. Mason:

Thank you for your letter of August 27, 1962 wherein you enclosed a copy of the Butterfield patent.
As you will recall, in my letter of August 15, 1962 I asked you to inform me as to how and in what manner our client has infringed upon your client's patent, namely, what is the specific basis for your claim that Dr. Golden has infringed upon the Butterfield patent? Is it your contention that the use of a bi-curved or multi-curved lens automatically infringes upon the Butterfield patent?

Naturally, we will be analyzing your client's patent but in addition I would appreciate if you would answer the

above questions so that we can specifically pinpoint the areas in which your client claims we are infringing. Thank you for your cooperation.

Sincerely,
FENTON, NEDERLANDER, TRACY & DODGE
By /s/ R. Nederlander
Robert E. Nederlander

REN:sm
CC: Dr. Donald L. Golden

• • •

PLAINTIFF'S EXHIBIT No. 143C

September 4, 1962

Mr. Robert E. Nederlander
Fenton, Nederlander, Tracy & Dodge
2555 Guardian Building
Detroit 26, Michigan

Re: *Butterfield Patent*

Dear Mr. Nederlander:

Replying to your letter of August 30th.

You apparently misunderstood our letter of August 7th because we did not say that your client had infringed the Butterfield patent. In fact, we did not have sufficient information to form an opinion as to whether an infringement had actually occurred or was contemplated.

Our only information was that obtained from the prospectus of the Acrylic Optics Corporation, which indicated that its lens was to have a concave surface defined by more than one curve, and we believed it only fair to advise the new company in the beginning, so that it could

avoid infringement. We assumed, of course, that the new company would obtain and be guided by an opinion from its own counsel with respect to the Butterfield patent. We merely mention that the owner of the Tuohy patent is a licensee under the Butterfield patent, and that it had stipulated for judgment in the Portland action holding that its predecessor in interest, Solex, had infringed the patent, because we felt that its counsel would want to consider such information in arriving at their conclusion in the matter.

We would prefer not to express our own views as to the scope of the Butterfield patent because, as you of course know, in the final analysis that is something which only the courts can determine.

Sincerely yours,
of MASON & GRAHAM

CM B
bc: Dr. George H. Butterfield, Sr.
Mr. Rupert R. Bullivant

DEFENDANT'S EXHIBIT Q

October 2, 1962

Mr. Elliott I. Pollock
Moore, Hall and Pollock
1200 Eighteenth Street, N.W.
Washington 6, D.C.

Re: *Contact Lenses*

Dear Mr. Pollock:

I have your letter of September 28th, and enclose two copies of Dr. Butterfield's paid-up license form, which I think more or less answers all your questions.

Of course, I do not know who the licensee is for whom you are inquiring, or how many lenses it has sold in the past, but I can tell you generally the basis upon which Dr. Butterfield arrives at the sum to be paid for a paid-up license and a release for past infringement:

He estimates the number of lenses to be sold hereafter until the end of the term of the patent (about six years) by taking the average number of lenses which the licensee has sold in the past two years, and considers that it will probably sell an equal number of lenses per year during the remaining life of the patent. Then, instead of his regular per lens royalty of 50 cents, which he charges for a license on a per-lens basis, he makes the royalty 37½ cents per lens for the paid-up form of license because thereby he saves accounting expenses.

In other words, to state an example, if during the past two years your client has sold an average of 4,000 lenses per year, he would figure that during the next six years they would sell 24,000 lenses, which, at 37½ cents per lens, would be $9,000.00, which would be the paid-up sum.

The example which I have given may be out of line because the average corneal lens manufacturer probably sells far more than 4,000 lenses per year.

Of course, your client does not have to pay all this amount at one time but, if it so desires, it can be paid so much down and so much per month until the total sum is paid. In fact, the license contemplates this.

Very truly yours,
of MASON & GRAHAM

CM B
Encs.
bc: Dr. George H. Butterfield, Sr.
Mr. Rupert R. Bullivant
(with copy of letter from Pollock
dated September 28, 1962)

EXCERPTS FROM TRIAL TRANSCRIPT

(Part of the testimony on cross examination of plaintiff George H. Butterfield, Sr., Tr. 407-408, 416-417, 420-422, 437-438)

BY MR. McDOUGALL:

* * * *

Now, you have, have you not, Doctor, on various occasions, orally and in writing, indicated the scope of your patent to be all contact lenses in which a central zone is formed with a spherical curve to conform to the apex of the cornea and then on which the marginal portion of it is provided with a different curve than the central curve?

A. I think that is what the patent says.

Q. On these occasions you have just said nothing about the further requirement in the patent that the peripheral or marginal curve conform to the cornea?

A. Well, I don't recall any letters that I sent out of that nature.

* * * *

Q. Were you asked any questions about the Tuohy patent?

A. I would not discuss the patents at all.

Q. Either one?

A. I discussed my own.

Q. Did you describe the area of your claim?

A. I gave them my opinion as to what my patent covered.

Q. And what is your opinion, Doctor?

A. Well, my opinion is that—I started to describe my lens this morning—a lens that has a central optical area which conforms to the curvature of the cornea and has

a secondary curvature surrounding it which is different than the one in the middle.

* * * *

Q. Very good. Now, taking into account your explanation as to how you arrived at the monthly payments, it is a fact today, is it not, that the bulk of your licensees and substantially all of them that have signed up within the period since the settlement of the lawsuit are paying royalties to you that are based on their total production of contact lenses as opposed to their production and sale of lenses that come under your patent?

A. Less 25 per cent.

Mr. Bullivant: Objected to. The license agreements are the best evidence, your Honor.

The Court: Well, the witness may answer. What is your answer to the question?

The Witness: I said Yes, but the rate is at a 25 per cent reduced rate over a unit license.

* * * *

Q. The fact is that during your initial conversations with the people who signed these paid-up licenses, you explained to them that the reduction in rate from a dollar per pair to 75 cents or, if you like, from 50 cents per lens to 37½ was because the simplified arrangement saved you the expense of accounting?

A. No.

Q. Is it your testimony now that you told these people that the reduction in rate was because of your recognition that some of their lenses might not come under the patent?

A. Well, I think it was rather a combination of simplifying their bookkeeping, simplifying my bookkeeping, simplifying the fact that I wouldn't have to send traveling auditors around, which costs money to audit their books.

This way I knew if a man agreed to pay me a hundred dollars a month, I was going to get a hundred dollars a month and he wasn't going to chisel on me, where under unit licenses, they might report a hundred lenses and make two hundred.

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Q. What is the fact, Dr. Butterfield, with respect to the royalty that you have charged on uncuit or semi-finished lenses in your license relations with manufacturers? Have you ever charged a different or a lower royalty for uncut or semi-finished lenses than you charged for finished lenses?

Mr. Bullivant: If the Court please, I am going to make the point that the contracts which are in evidence are the best evidence.

The Court: Overruled.

The Witness: Have I ever charged less, you say, for uncuts?

Q. Well, the point I make is that you have always charged the same royalty for uncuts as you did for finished, finished lenses; isn't that so?

A. We have three different types of licenses.

Q. And in all three of them there is no distinction made as far as royalty is concerned between uncuts and finished lenses; isn't that true?

A. That's true.

(Excerpts from the testimony of plaintiff's witness James C. Dippery, Tr. 205-206, 235)

BY MR. BULLIVANT:

. . . . .

Q. Now, before you actually started operating under the contract, did you have any further conversations with Dr. Butterfield dealing with the subject of what you should and should not say?

A. I did.

Q. In your activities?

A. I did.

Q. When did those conversations occur?

A. They occurred in our meeting at Dallas and several times by phone.

Q. Were those occasions before and after the execution of this contract?

A. Mostly before.

Q. Now, what was discussed on that subject between you and Dr. Butterfield?

A. That anyone using a second curve or a bi-curve other than the base curve of the lens was infringing on the Butterfield patent. . . .

. . . . .

By MR. MC DOUGALL:

Q. If you found a secondary curve on the lens, this was enough to convince you that the man who made the lens was infringing the Butterfield patent?

A. Yes, sir.

(Excerpts from the testimony of plaintiff's witness Jerome B. Conlogue, Tr. 306-308, 324-326)

* * * *

Direct Examination by Mr. Bullivant.

Q. You are Dr. Jerome B. Conlogue?

A. I am.

Q. Will you please state your business or profession?

A. I am an optometrist. I also am a manufacturer—owner of a manufacturing laboratory of contact lenses. I have been in the practice of optometry since 1933, and in the contact lens field since 1938, except for four years of Navy duty. . . .

* * * *

Q. What type of clientele is served by the manufacturing business?

A. Well, the fitters in the field. The general classification would be optometrists, ophthalmologists and dispensing opticians.

Q. In your own professional practice have you carried that on recently on an active basis in the fitting of lenses to the eyes of patients?

A. Am I personally fitting?

Q. Yes.

A. Yes.

* * * *

Q. In your manufacturing business, Doctor, will you state whether or not the orders that are filled there are orders on prescriptions from fitters or orders for sale to others?

A. They are orders on prescriptions from fitters.

Q. What portion of the volume of your manufacturing is on a prescription basis?

A. I would say 100 per cent.

Q. I see. Can you give us any idea how many lenses, corneal lenses, you fit in your practice as an optometrist?

A. Well, I started keeping track about two and a half years ago, and I think my combined number was around twenty-one or twenty-two hundred. That is starting back about '57. I would say in the last few years I have averaged around between 200 and 250. I haven't broken it down. But in my lifetime I would say over 4,000.

Q. Over what? I can't hear you.

A. Over 4,000.

Mr. Bullivant: You may cross-examine.

Cross Examination by Mr. McDougall.

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Q. What is the fact, incidentally, with regard to a lens that you make in response to a prescription from a customer, say? Are you able to determine from an examination of the lens itself or from a reading of the prescription whether it is a lens that conforms to the cornea for which it is prescribed over its entire surface?

A. No.

Q. So one can fairly say that you, as a manufacturer, in carrying out the prescriptions that your customers send in to you, had no way of knowing in any given instance whether you were operating under one patent or another or operating under no patent at all; isn't that so?

A. I can't make that judgment.

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